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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,461	06/09/2000	MICHAEL J. NOVOSEL	RRE-P-00-001	4477

23560 7590 09/24/2002

PATENTS & TMS, P.C.
1914 NORTH MILWAUKEE AVENUE
CHICAGO, IL 60647

EXAMINER

SMITS, TALIVALDIS IVARS

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 09/24/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/592,461

Applicant(s)
Michael J. Novosel Jr. et al.

Examiner
Talivaldis Ivars Smits

Art Unit
2654



itG

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 10 and June 6, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 is/are allowed.
- 6) ☒ Claim(s) 21-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on June 6, 2002 after Final Rejection and Advisory Action. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on April 10, 2002 have been entered.

Response to Amendment

2. The Affidavits and Appendix references filed on April 10, 2002 under 37 CFR 1.131 are sufficient to overcome the 1996 SoundTraxx Digital Command Control Digital Sound Decoder reference, by establishing conception and diligence, from a date prior to the date of reduction to practice of the 1966 reference, to either a constructive reduction to practice or an actual reduction to practice. Therefore claims 1-20, the claims of the patented parent application, are allowable.

However, the new claims, claims 21-50, added for the instant reissue application, are rejected as being impermissible recapture of subject matter previously surrendered by applicant's amendment of their first application in the chain, 08/289,257 of August 11, 1994, of which the patented parent application was a CIP.

Allowable Subject Matter

3. Claims 1-20 are allowed over the prior art of record for reasons given in paragraph 6 of Paper No. 4 of the parent (CIP) application 08/851,200, modified per below.

Specifically, the sole independent claim 1 of the CIP application was allowed because “it recites storing at predetermined addresses in an analog memory contained in a model train a plurality of sound effects, controlled by an integrated analog-sound/motor/special-effects controller which uses bi-polar digital signal packets to, *inter alia*, recall for playback said analog sounds effects from said memory in a predetermined or a random sequence, when the corresponding digital packet triggers its sound effect”. And, dependent claims 2-20 were allowed because they further limit claim 1 or their parent claims.

Applicant correctly pointed out in Amendment B (Paper No. 9) that the examiner inadvertently included the word “analog” in his above-quoted Reasons for Allowance, quoted above, despite said word having been cancelled by applicant’s Amendment. However, applicants failed to point this error out in response to examiner’s solicitation for applicants’ comments on said Reasons for Allowance, to be submitted no later than the payment of the issue fee. But this issue is moot, since the presence or absence of the word “analog” was not critical for the allowance, which was based on a non-obvious combination of the other limitations, particularly the recitation of **integrated sound/ motor/special-effects controller which uses bi-polar digital signal packets**.

4. The above-mentioned (combination) limitation of an integrated analog-sound/motor/special-effects controller using bi-polar digital signal packets to play stored analog sound effects in a predetermined or random sequence from predetermined addresses was added to claim 1 of the original application 08/289,257 when amending it for the CIP. Thus, it was originally **presented/argued/stated** in the parent application to make the claims allowable over the Final Rejection made to the original application

Claim Rejections - 35 USC § 251

5. New claims 21-50 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ289, 295 (Fed. Cir. 1984).

Neither the sole new independent claim 21, nor dependent claims 22-50 include **all** of the (combination) limitations, cited in the reasons for allowance under **Allowable Subject Matter**, above, which made the CIP application allowable.

Specifically, independent claim 21 does not recite “**an integrated sound, motor, and special effects controller**”, nor a controller “**controlled by a bi-polar digital signal**”, nor “a controller ... **recalling the sound effects of either one or a plurality of sound effects in a**

predetermined sequence or a random sequence” by means of a bi-polar digital signal, which **combined limitations**, newly-recited in the CIP application, were part of the reasons for making claim 1 allowable. None of dependent claims 22-50 cures this defect.

Therefore, since the limitations now being omitted or broadened in the present reissue were **presented/argued/stated** in the original application to make the claims allowable for the Patent, the omitted limitations relate to subject matter previously **surrendered** by applicant, and impermissible **recapture** exists.

Accordingly, the argued narrow scope of claim 1 in the patent was not an “error” within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Conclusion

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or FAXed to:


(703) 872-9314 (please label *formal* communications
“OFFICIAL”; please label *informal* or draft communications,
“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-3011. The examiner can normally be reached Mondays-Fridays from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold, can be reached on (703) 305-4379. The facsimile phone number for Technology Center 2600 is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 customer service, whose telephone number is (703) 306-0377.



TĀLIVALDIS IVARS ŠMITS
PRIMARY EXAMINER

Art Unit 2654
September 23, 2002